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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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09/868,515

06/18/2001

Klaus Schelberger

49651

1391

26474

7590

03/10/2003

KEIL & WEINKAUF  
1350 CONNECTICUT AVENUE, N.W.  
WASHINGTON, DC 20036

EXAMINER

JIANG, SHAOJIA A

ART UNIT

PAPER NUMBER

1617

DATE MAILED: 03/10/2003

14

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action***(Supplemental)*

Applicati n No.

09/868,515

Applicant(s)

SCHELBERGER ET AL.

Examiner

Shaojia A. Jiang

Art Unit

1617

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 02 December 2002 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☒ A Notice of Appeal was filed on 30 December 2002. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attachment.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: none.Claim(s) objected to: none.Claim(s) rejected: 1,9 and 10.Claim(s) withdrawn from consideration: none.

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*[Signature]*  
SREENI PADMANABHAN  
PRIMARY EXAMINER

3/6/05

***Advisory Action***

In view of Applicants' petition under 37 CFR 1.181, filed on December 30, 2002 and the petition granted February 27, 2003, Applicants amendment filed December 2, 2002 has been entered in Paper No. 9, wherein claims 1, 9 and 10 have been amended and claims 2-8 and 11 are cancelled. Currently, claims 1, 9 and 10 are pending in this application.

5. Applicant's remarks filed December 2, 2002 with respect to the rejection of the remaining claims 1, 9 and 10 made under 35 U.S.C. 112, first paragraph, for lack of enablement have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated August 27, 2002.

As discussed in the Final Rejection, synergistic or superadditive effects for combinations of compounds are highly unpredictable. In the instant case there is insufficient guidance or working examples in the specification showing amounts and particular agents to be combined which achieve synergistic effects by the fungicidal composition in the method for controlling fungi herein. In this regard, the testing herein merely demonstrate three particular compounds Ia, Ib, and Ic in combination with Iia (a single compound of the formula II), within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the active compounds in the claimed composition. See MPEP § 716.02(d).

Therefore, in view of the *Wands*, factors, 8 USPQ2d 1400 (CAFC 1988), the unpredictability of such synergistically effective amounts of the claimed combination, the

guidance in the specification is considered insufficient to show one of skill in the art how to practice the claimed invention without undue experimentation.

Applicants are suggested to change to "effective amount" from "a synergistically effect amount" in the claim.

Applicant's remarks filed December 2, 2002 with respect to the rejection of the remaining claims 1, 9 and 10 made under 35 U.S.C. 103(a) as being unpatentable over Schwalge et al. (WO 97/06681) and Kasahara et al. (WO 96/19442, equivalent to US 5,847,005) have been fully considered but are unpersuasive for reasons of record stated in the Final Office Action dated August 27, 2002.

As discussed in the Final Rejection, Applicant's data shown in Ammermann's declaration and the specification herein have been fully considered with respect to the nonobviousness and/or unexpected results of the claimed invention over the prior art but are not deemed persuasive, as discussed above regarding the rejection made under 35 U.S.C. 112, first paragraph, for lack of enablement. In this regard, the testing herein merely demonstrate three particular compounds Ia, Ib, and Ic in combination with lia (a single compound of the formula II), within the instant claims. Thus, the evidence in the examples is also not commensurate in scope with the claimed invention and does not demonstrate criticality of a claimed range of the active compounds in the claimed composition. See MPEP § 716.02(d). Therefore, the evidence presented in specification herein is not seen to support the nonobviousness of the instant claimed invention over the prior art.

Thus, the claimed invention is clearly obvious in view of the prior art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Jiang, whose telephone number is (703) 305-1008. The examiner can normally be reached on Monday-Friday from 9:00 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreenivasan Padmanabhan, Ph.D., can be reached on (703) 305-1877. The fax phone number for the organization where this application or proceeding is assigned is (703) 308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-1235.

Shaojia A. Jiang, Ph.D.  
Patent Examiner, AU 1617  
March 5, 2003